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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/895,050	06/29/2001	Michel G. M. Perbost	10991394-5	3224

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AGILENT TECHNOLOGIES, INC.  
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EXAMINER

CHAKRABARTI, ARUN K

ART UNIT PAPER NUMBER

1634

DATE MAILED: 02/13/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.  
09/895,050

Applicant(s)

Perbost

Examiner  
Arun Chakrabarti

Art Unit  
1655



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on Jun 29, 2001
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 29-31 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 29-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Election/Restriction***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-28, drawn to method of fabricating an addressable array of biopolymers, classified in class 427, subclass 333.
  - II. Claims 29-31, drawn to an apparatus, classified in class 222, subclass 216+.
  - III. Claims 32-33, drawn to a computer program product, classified in class 712, subclass 10+.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions of Group I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the method of fabricating an addressable array of biopolymers of Group I can be practiced by the apparatus of Group II or manually by hand .
3. Inventions of Group I and III are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case , the

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method of fabricating an addressable array of biopolymers of Group I can be practiced by the computer program product of Group III or manually by hand .

4. Inventions of Group II and III are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product apparatus of Group II is deemed to be useful as making the computer program product of Group III or fabricating an addressable array of biopolymers and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

6. During a telephone conversation with Gordon Stewart on August 22, 2001, a provisional election was made with traverse to prosecute the invention of Group II, claims 29-31.

Affirmation of this election must be made by applicant in replying to this Office action. Claims

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1-28 and 32-33 withdrawn from further consideration by the examiner, 37 CAR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 29-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 29 is rejected over the recitation of the phrase, "biomonomer monomer". It is not clear if the last mentioned monomer is a chemical monomer or biomonomer or both. The metes and bounds of the claims are vague and indefinite.

Regarding claims 30 and 31, the phrases "including" and "includes" render the claims indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 29 and 30 are rejected under 35 U.S.C. 102 (b) as being anticipated by Baldeschwieler et al. (PCT International Application NO: WO 95/25116) (September 21, 1995).

Baldeschwieler et al teach an apparatus for fabricating an addressable array of biopolymers on a substrate according to a target pattern (Abstract), comprising:

(a) a deposition system which can separately dispense onto a substrate, fluid compositions of different biomonomers each with a first linking group which must be activated for linking to a substrate bound moiety, and a fluid composition of a solid activator (Claims 28 and 29 and Figures 2 and 4 and Example 1);

(b) a processor to operate the deposition system, which processor derives from the target array pattern a target drive pattern for operating the deposition system to form the array, the target drive pattern including instructions to the deposition system to deposit the fluid composition of solid activator at each region at which a biomonomer monomer is to be deposited, separate from and preceding deposition of the biomonomer (Example 1, Page 19, lines 3-33 and Claims 28 and 29 and page 13, lines 16-21).

Baldeschwieler et al teach an apparatus wherein the deposition system comprises multiple jets which can dispense droplets of the different biomonomer fluid compositions and at least one pulse jet which can separately dispense the activator fluid composition, each jet including a chamber with an orifice, and including an ejector which, when activated, causes a droplet to be ejected from the orifice (Page 13, lines 3-34 and Figures 2 and 4).

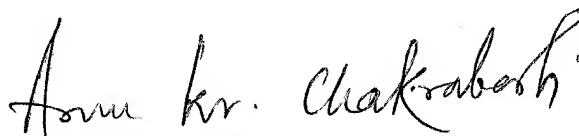
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*Allowable Subject Matter*

11. No prior art rejection has been made against claim 31.

*Conclusion*

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arun Chakrabarti, Ph.D., whose telephone number is (703) 306-5818. The examiner can normally be reached on 7:00 AM-4:30 PM from Monday to Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones, can be reached on (703) 308-1152. The fax phone number for this Group is (703) 305-7401. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

  
Arun Chakrabarti,

Patent Examiner,

February 11, 2002